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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/215,804	12/18/1998	MARK GAVIN	D3239-00002	1595
8933	7590	09/16/2005	EXAMINER	
DUANE MORRIS, LLP IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196			BASHORE, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/215,804	GAVIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	William L. Bashore	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-14, 16-22, 24 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14, 16-22, 24, 26-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This action is responsive to communications: amendment filed 7/5/2005, to the original application filed 12/18/1998.
2. The rejection of claims 1-6, 8-14, 16-22, 24, 26-30 under 35 U.S.C. 103(a) as being unpatentable over Anderson and Redax, has been withdrawn as necessitated by amendment.
3. Claims 1-6, 8-14, 16-22, 24, 26-34 pending. Claim 25 has been canceled. Claims 31-34 have been added. Claims 1, 5, 9, 13, 17, 21, 26 are independent claims.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **The claimed invention, as claimed in claims 26-27 remain directed to non-statutory subject matter (see section Response to Arguments below).**

**In regard to independent claim 26**, the combined limitations within said claim can be fairly interpreted as a series of mental and/or manual steps (i.e. manually redacting from a printed document, or printed PDF file, mentally parsing, a manual system, etc.), and is therefore directed to non-statutory subject matter. The examiner's suggestion of amending the preamble of said claim to read "*A computer implemented method...*" will serve to overcome this rejection.

**In regard to dependent claim 27**, claim 27 is rejected for fully incorporating the deficiencies of their respective base claims.

***Claim Rejections - 35 USC § 103***

**6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claims 1-2, 5-6, 8-10, 13-14, 16-18, 20-22, 24, 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (hereinafter Anderson), U.S. Patent No. 5,581,682 issued December 3, 1996, in view of Rackman, U.S. Patent No. 5,903,646 issued May 1999 (made of record in a previous Office action mailed 3/26/2002).**

**In regard to independent claim 1**, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 1 preamble “*A method of redacting content from a document in electronic form, comprising the steps of*”).

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or area of content to be redacted (Anderson Abstract, Figures 1, 3B, 5 also column 3 lines 33-39, column 7 Table II line “Object Area Position”; compare with claim 1 “*selecting a geometric area on the document for redaction, said geometric area having content comprising at least one image*”, and “*representing said geometric area as one or more annotation objects*”). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

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Anderson teaches identification of information representing content/location/nature of content, said information represented as objects (i.e. image objects) (Anderson Abstract, Figure 1, 3B, also column 6 lines 15-20; compare with claim 1 “*identifying information in the document representing content and location and nature of content*”, and “*representing said identified information as one or more content objects, said one or more content objects comprising one or more image occurrence objects;*”).

Anderson teaches a final-form document with annotated and/or redacted areas present in said document, with content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 1 “*identifying content....to produce a redacted document.*”).

Anderson teaches that, although the underlying original archived document is not changed, a reviewer with a low security clearance may see only the displayed redacted version of said document (Anderson column 2 lines 43-47). Anderson does not specifically disclose “an output file” with said (image based) content not present, hence allowing a redacted document to be producible from said output file. However, Rackman teaches a method of redacting an electronic document, whereby a redacted document is saved in final redacted form (Rackman Abstract, column 2 lines 53-61). It is noted that Rackman’s disk contains two images (i.e. two documents), one in unredacted encrypted form, and one in (permanent) redacted form (i.e. the redacted content is not found in the document). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Rackman to Anderson, providing Anderson the benefit of saving the displayed image redactions within a final pdf document for portability reasons (i.e. law firms submitting briefs to the U.S. courts with redacted private information from public documents) (compare with claim 1 “*creating an electronic output file, said identified content not present in said output file, a redacted document being reproducible from said output file for display.*”). Applying Rackman would also provide ultimate security by preventing any possibility of reverse engineering to reveal sensitive content from the redacted document.

**In regard to dependent claim 2**, Anderson teaches items of information (including text) associated with an annotation object (Anderson column 6 lines 12-21; compare with claim 2).

**In regard to independent claim 5**, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 5 preamble “*A method of designating portions of a document for redaction, comprising the steps of*”).

Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with claim 5 “*displaying all or a portion of the document*”).

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or redaction (Anderson Abstract, Figures 1, 3B, 5, also column 3 lines 33-39, column 7 Table II line “Object Area Position”; compare with claim 5 “*designating a geographical region of the document for redaction*”). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects producing a final-form document with annotated and/or redacted areas are present in said document (Anderson Abstract, column 2 lines 25-30, Figure 1, 3B, also column 6 lines 15-20, column 5 lines 47-52). Anderson does not specifically disclose “saving” designations with the document, hence allowing a redacted (image) document to be producible from said output file. However, Rackman teaches a method of redacting an electronic document, whereby a redacted document is saved in final redacted form (Rackman Abstract, column 2 lines 53-61). It is noted that Rackman’s disk contains two images (i.e. two documents), one in unredacted encrypted form, and one in (permanent) redacted form (i.e. the redacted content is not found in the document). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Rackman to Anderson, providing Anderson the benefit of saving the displayed image redactions within a final pdf document for portability reasons (i.e. law firms submitting briefs to the U.S. courts

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with redacted private information from public documents) (compare with claim 5 “*saving the designations with the document*”). Applying Rackman would also provide ultimate security by preventing any possibility of reverse engineering to reveal sensitive content from the redacted document.

Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document (Anderson column 6 lines 12-20, Figure 3A-3B, 4). Anderson also teaches an Image Object, and a Graphics Object, comprising geometric areas of a page (Anderson Abstract, Figures 1, 3B, 5, also column 3 lines 33-39, column 7 Table II line “Object Area Position”) (compare with claim 5 “*wherein the step of designating comprises manipulating a frame displayed on the document, content....visible to the user during said step of manipulation, said content comprising at least one image.*”), teaching the manipulation and orientation (framing) of an object on a page.

Applying the above limitation regarding manipulation of a frame, to a redaction, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches application of overlays to both annotations and redactions (see Anderson Figure 5). Since a document annotation can be subject to redaction, it would have been obvious to add and/or combine the redaction overlay with the annotation overlay, providing the advantage of extra security via redaction of user annotations.

**In regard to dependent claim 6**, Anderson teaches the use of descriptions and stored as offsets (Anderson columns 4 lines 12-24, columns 6-9 Tables I - III; compare with claim 6).

**In regard to dependent claim 8**, Anderson does not specifically teach batch designation. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches “include” structures within a page, with more than one include structure per page (for each annotation/redaction) (Anderson column 3 lines 40-48). Anderson also teaches a state register set if default is for a user to view all annotations on a page (Anderson column 5 lines 28-35; compare the above with claim 8), suggesting the processing of annotations/redactions as performed in a batch manner, providing the advantage of efficient batch (all at once) processing.

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**In regard to claims 9-10**, claims 9-10 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 1-2, respectively and are rejected along the same rationale.

**In regard to claims 13-14**, claims 13-14, reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 5-6, respectively , and are rejected along the same rationale.

**In regard to claim 16**, claim 16 reflects the medium comprising computer executable instructions used for performing the methods as claimed in claim 8, and is rejected along the same rationale.

**In regard to claims 17-18, 20**, claims 17-18, 20 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 1, 2, and are rejected along the same rationale.

**In regard to claims 21-22**, claims 21-22 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 5-6, and are rejected along the same rationale.

**In regard to claim 24**, claim 24 reflects the system comprising computer executable instructions used for performing the methods as claimed in claim 8, and is rejected along the same rationale.

**In regard to dependent claims 28-30**, Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with *“displaying all or a portion of a document”*).

Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document (Anderson column 6 lines 12-20, Figure 3A-3B, 4; compare with



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*“manipulating a frame displayed on the document, content....visible to the user during said step of manipulation.”*), teaching the manipulation and orientation (framing) of an object on a page.

**In regard to dependent claims 31-33**, Anderson does not specifically teach replacement via pixel by pixel. However, Rackman teaches redaction involving images and does mention pixels (Rackman Abstract, column 2 lines 53-61). Since modification of images in an electronic document generally involve modification of its representative pixels, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement redaction via pixel by pixel replacement and/or modification, providing the benefit of image based redaction.

8. **Claims 3-4, 11-12, 19, 26-27, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, and Rackman, and further in view of Redax (hereinafter Redax), Web article by Digital Applications, Inc., downloaded on 3/10/2005, with a last update of 12/13/1997, downloaded from <<http://web.archive.org/web/19971221013620/http://digapp.com/>>, pages 1-2.**

**In regard to dependent claim 3**, Anderson teaches items of information (including text) associated with an annotation object (Anderson column 6 lines 12-21; compare with claim 3).

Anderson does not specifically disclose an output file with “text” content not present, hence allowing a redacted document to be producible. However, Redax teaches a method of redacting an electronic PDF document, whereby a redacted document is saved in final redacted form (i.e. redacted text is permanently removed) (Redax page 1 paragraph 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax to Anderson, providing Anderson the benefit of saving the displayed redactions within a final document for portability reasons (i.e. law firms submitting briefs to the U.S. courts with redacted private information from public documents - see Redax page 1 paragraph 2). Applying Redax would also provide ultimate security by preventing any possibility of reverse engineering to reveal sensitive content.

**In regard to dependent claim 4**, Anderson/Rackman/Redax teaches a final-form document with annotated and/or redacted images/text are present in said document, said annotations permanently replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 4).

**In regard to claims 11-12**, claims 11-12 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 3-4, and are rejected along the same rationale.

**In regard to claim 19**, claim 19 reflects the medium comprising computer executable instructions used for performing the methods as claimed in claim 3, and is rejected along the same rationale.

**In regard to independent claim 26**, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract).

Anderson does not specifically teach a PDF file. However, Redax taught redaction as applied to a PDF file (Redax paragraph 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax to Anderson, providing Anderson the benefit of redacting PDF documents, increasing the versatility of Anderson as applied to a wider variety of document types.

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or area of content to be redacted (Anderson Abstract, Figures 1, 3B, 5 also column 3 lines 33-39, column 7 Table II line "Object Area Position"). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects (i.e. image objects) (Anderson Abstract, Figure 1, 3B, also column 6 lines 15-20).

Anderson teaches a final-form document with annotated and/or redacted areas present in said document, with content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52).

Anderson teaches that, although the underlying original archived document is not changed, a reviewer with a low security clearance may see only the displayed redacted version of said document (Anderson column 2 lines 43-47). Anderson does not specifically disclose “an output file” with said (image based) content not present, hence allowing a redacted document to be producible from said output file. However, Rackman teaches a method of redacting an electronic document, whereby a redacted document is saved in final redacted form (Rackman Abstract, column 2 lines 53-61). It is noted that Rackman’s disk contains two images (i.e. two documents), one in unredacted encrypted form, and one in (permanent) redacted form (i.e. the redacted content is not found in the document). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Rackman to Anderson, providing Anderson the benefit of saving the displayed image redactions within a final pdf document for portability reasons (i.e. law firms submitting briefs to the U.S. courts with redacted private information from public documents). Applying Rackman would also provide ultimate security by preventing any possibility of reverse engineering to reveal sensitive content from the redacted document.

Anderson does not specifically disclose an output file with “text” content not present, hence allowing a redacted document to be producible. However, Redax teaches a method of redacting an electronic PDF document, whereby a redacted document is saved in final redacted form (i.e. redacted text is permanently removed) (Redax page 1 paragraph 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax to Anderson, providing Anderson the benefit of saving the displayed redactions within a final document for portability reasons (i.e. law firms submitting briefs to the U.S. courts with redacted

private information from public documents - see Redax page 1 paragraph 2). Applying Redax would also provide ultimate security by preventing any possibility of reverse engineering to reveal sensitive content.

**In regard to dependent claim 27**, Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with *"displaying all or a portion of a document"*).

Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document (Anderson column 6 lines 12-20, Figure 3A-3B, 4; compare with *"manipulating a frame displayed on the document, content....visible to the user during said step of manipulation."*), teaching the manipulation and orientation (framing) of an object on a page.

**In regard to dependent claim 34**, Anderson does not specifically teach replacement via pixel by pixel. However, Rackman teaches redaction involving images and does mention pixels (Rackman Abstract, column 2 lines 53-61). Since modification of images in an electronic document generally involve modification of its representative pixels, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement redaction via pixel by pixel replacement and/or modification, providing the benefit of image based redaction.

### ***Response to Arguments***

9. Applicant's arguments filed 6/18/2004 have been fully and carefully considered but they are currently moot in view of the new grounds of rejection. It is noted that the examiner has now introduced Rackman to teach Applicant's amended limitations.

In addition, the examiner retains the previous rejection of claims 26-27 under 35 U.S.C. 101 as being directed to non-statutory subject matter. Although Applicant's conclusion is based on the fact that the examiner did not indicate these two claims in the header, however, these two claims were rejected and addressed in the

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rejections themselves in the previous Office action (the omission in the header was an unintentional oversight), therefore the examiner respectfully maintains said rejection.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**WILLIAM BASHORE  
PRIMARY EXAMINER**

September 14, 2005